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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,934	11/25/2003	Rita Bitzer	10537/171A	9401
26646	7590	12/09/2009	EXAMINER	
KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004			GREEN, ANTHONY J	
ART UNIT	PAPER NUMBER			
1793				
MAIL DATE	DELIVERY MODE			
12/09/2009		PAPER		

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* RITA BITZER and HALF PASSOTH

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Appeal 2009-005690  
Application 10/723,934  
Technology Center 1700

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Decided: December 09, 2009

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Before EDWARD C. KIMLIN, BRADLEY R. GARRIS, and  
ADRIENE LEPIANE HANLON, *Administrative Patent Judges*.

Opinion for the Board filed by KIMLIN, *Administrative Patent Judge*.

GARRIS, *Administrative Patent Judge*, dissenting-in-part.

**DECISION ON APPEAL**

This is an appeal from the final rejection of claims 2-10, 12-17, 27 and 31. We have jurisdiction under 35 U.S.C. § 6(b).

Claim 10 is illustrative:

10. A corrosion protective brake lacquer for producing a corrosion protective coating composition for a braking surface of at least one of a brake disk and a brake drum, comprising:

a protective substance configured to at least one of chemically react with oxygen and bind with oxygen;

wherein the protective substance has an average grain size that is substantially equal to at least one of a maximum roughness and an average size of score marks of the braking surface of the at least one of the brake disk[s] and the brake drum.

The Examiner relies upon the following references in the rejection of the appealed claims (Ans. 2):

Spehner	DE 4314432	Oct. 11, 1994
Clerici	EP 0976795 A2	Feb. 02, 2000

Appellants' claimed invention is directed to a corrosion protective brake lacquer. The lacquer comprises a substance that chemically reacts or binds with oxygen, such as zinc and iron. The substance has an average grain size that is substantially equal to either the maximum roughness, average size of score marks, or average pore diameter of the braking surface to which the lacquer is applied.

Appealed claims 2-10, 12-17, 27, and 31 stand rejected under 35 U.S.C. § 112, first paragraph, enablement requirement. Claims 2-10, 12-17, 27 and 31 also stand rejected under 35 U.S.C. § 112, second paragraph. Claims 2-4, 10, 12-14, 17, 27, and 31 stand rejected under 35 U.S.C. § 102(b) as being anticipated by DE '432. Claims 2-7, 10, 12-17, 27, and 31 stand rejected under 35 U.S.C. § 102(b) as being anticipated by EP '795.

Regarding the prior art rejections, Appellants do not present separate, substantive arguments for any particular claim on appeal. Accordingly, the appealed claims rejected under § 102 stand or fall together.

We consider first the rejection under § 112, first paragraph, enablement requirement. It is the Examiner's position that Appellants' Specification would not enable one of ordinary skill in the art to practice the claimed invention because no guidance is provided concerning the grain size encompassed by the claim language "substantially equal to at least one of a maximum roughness and an average size of score marks of the braking surface" and "substantially equal to at least one of a maximum roughness, an average pore diameter and an average size of score marks of the braking surface" (claims 10 and 17). However, although the appealed claims are extensively broad in that they encompass a virtually unlimited range of grain sizes for the protective substance, we agree with Appellants that the skilled artisan would need to resort to no more than routine experimentation to determine the roughness, average size of score marks, and average pore diameter of a particular braking surface and, consequently, be able to select an appropriate grain size for the protective substance. The Examiner has not demonstrated that undue experimentation would be required of the skilled artisan in order to ascertain the appropriate grain size for a specific braking surface.

We do agree with the Examiner, however, that the claimed subject matter is indefinite within the meaning of § 112, second paragraph. As noted, the claim recitations at issue are extensive in scope insofar as they embrace a virtual unlimited range for the claimed grain size. Consequently, since the claims define a lacquer composition, and not a process of coating a

brake surface with a protective composition, one of ordinary skill in the art of formulating a lacquer composition comprising a protective substance would not be fairly apprised of the grain sizes that would infringe the appealed claims. Stated otherwise, one of ordinary skill in the art of formulating lacquers for uses other than brake surfaces would not be reasonably apprised of the grain sizes for the protective substance that would be within and outside the scope of the appealed claims. While it is generally true that the breadth of a claim is not to be confused with its definiteness, a claim may be so broad in its scope that it fails to particularly point out and distinctly claim the invention, i.e., the claim is indefinite. *See Burlington Indus., Inc. v. Quigg*, 822 F.2d 1581, 1583-84 (Fed. Cir. 1987), and *In re Corkill*, 771 F.2d 1496, 1501 (Fed. Cir. 1985).

We will sustain the Examiner's § 102 rejections under the same rationale. There is no dispute that both references applied by the Examiner disclose a corrosion protective composition for brakes and similar articles comprising the claimed protective substance. Neither reference expressly teaches that the average grain size of the protective substance is substantially equal to the maximum roughness, average size of score marks, and/or pore diameter of the braking surface. However, since the appealed claims encompass an unlimited range of grain sizes that are substantially equal to the surface roughness and pore size of every conventional braking surface, we agree with the Examiner that conventional protective substances used in the applied references would necessarily have grain sizes that fall within the extensive scope of the appealed claims. Appellants have not disclosed any specific range for the grain size of the claimed protective substance such that the claimed grain size is distinguished over grain sizes typically used in the

compositions of the applied references. Since the appealed claims embrace every value for roughness and pore size of the braking surface, it would seem virtually impossible that the grain size for the prior art compositions would not fall within the scope of the appealed claims.

In conclusion, the Examiner's rejection under 35 U.S.C. § 112, first paragraph, is reversed whereas the rejection under 35 U.S.C. § 112, second paragraph, is affirmed. Also, the Examiner's rejections under 35 U.S.C. § 102(b) are sustained. Accordingly, the Examiner's decision rejecting the appealed claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a) (2008).

**AFFIRMED**

GARRIS, *Administrative Patent Judge*, dissenting-in-part.

I agree with the majority's decision to reverse the § 112, first paragraph, rejection and to affirm the § 102 rejections. However, I respectfully dissent from the decision of my esteemed colleagues to affirm the Examiner's § 112, second paragraph, rejection of claims 2-10, 12-17, 27, and 31.

As support for the affirmance of this latter rejection, the majority states that "one of ordinary skill in the art formulating a lacquer composition comprising a protective substance would be not be fairly apprised of what grain sizes would infringe the appealed claims" (Majority slip op. para. bridging 3-4). However, this statement is contrary to my colleagues' subsequent determination that the § 102 rejection should be affirmed because, *inter alia*, "the appealed claims encompass an unlimited range of grain sizes that are substantially equal to the surface roughness and pore size of every conventional braking surface" (*id.* at para. bridging 4-5). I agree with this determination and believe that it reflects how the appealed claims would be understood by those with ordinary skill in the art.

Assessing compliance with the second paragraph of § 112 requires determining whether those skilled in the art would understand what is claimed when the claim is read in light of the specification. *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986). Because I believe those skilled in the art would understand what is claimed, I would reverse the Examiner's § 112, second paragraph, rejection.

I recognize that illustrative independent claim 10 requires the protective substance to have "an average grain size that is substantially equal to at least one of a maximum roughness and an average size of score marks

of the braking surface of the at least one of the brake disk and the brake drum". However, this quoted recitation, although broad, is as accurate as the subject matter permits and therefore complies with the second paragraph of § 112. *See Orthokinetics* at *id.* (explaining why the patent claims under consideration did not violate the second paragraph of § 112):

The claims were intended to cover the use of the invention [i.e., a travel chair] with various types of automobiles. That a particular chair on which the claims read may fit within some automobiles and not others is of no moment. The phrase "so dimensioned" is as accurate as the subject matter permits, automobiles being of different sizes. . . . The patent law does not require that all possible lengths corresponding to the spaces in hundreds of different automobiles be listed in the patent, let alone that they be listed in the claims.

Similarly, it is of no moment that the appealed claims define an average grain size as being substantially equal to certain physical characteristics of braking surfaces. This definition complies with the second paragraph. The majority's opposing viewpoint is incorrect.

For the above-stated reasons, the Examiner's § 112, second paragraph, rejection of claims 2-10, 12-17, 27, and 31 should be reversed.

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